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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,581	06/24/2003	Gary Balakoff	44904.000736	8202

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EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT PAPER NUMBER

1772

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/601,581

Applicant(s)

BALAKOFF ET AL.

Examiner

Christopher P. Bruenjes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 7, 2005 has been entered.

WITHDRAWN REJECTIONS

2. The 35 U.S.C. 112 rejections of claims 1-15 of record in the Office Action mailed July 7, 2005, Pages 2-3 Paragraph 2, have been withdrawn due to Applicant's arguments in the Paper filed October 7, 2005.

REPEATED REJECTIONS

3. The 35 U.S.C. 103 rejections of claims 1-4 and 6-15 over Gotoh in view of Harvie are repeated for the reasons set forth in the previous Office Action mailed July 7, 2005, Pages 3-7 Paragraphs 3 and 4.

4. The 35 U.S.C. 103 rejection of claim 5 over Gotoh in view of Harvie and Okumra is repeated for the reasons set forth in the previous Office Action mailed December 14, 2004, Pages 6-7 Paragraph 3.

ANSWERS TO APPLICANT'S ARGUMENTS

5. Applicant's arguments regarding the 35 U.S.C. 112 rejections of claims 1-15 have been considered but they are moot since the rejections have been withdrawn.

6. Applicant's arguments regarding the 35 U.S.C. 103 rejections of claims 1-4 and 6-15 over Gotoh in view of Harvie have been fully considered but they are not persuasive.

In response to Applicant's argument that Gotoh teaches a chemical solution to prevent blocking and therefore would not be motivated to use a mechanical solution or to look for other ways to solve the problem to which Gotoh already teaches a solution. The fact that Gotoh teaches a solution to the problem of blocking does not in of itself teach away from forming a matte or roughened surface on the second side of the film.

In response to Applicant's argument that one skilled in the art would not be motivated to perform the combination of Gotoh

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and Harvie. Although Gotoh may solve the problem of blocking by a chemical solution and therefore does not provide prevention of blocking as a motivation for adding a roughened surface to the second surface of Gotoh, as taught by Harvie, there is still motivation to perform the combination of Gotoh and Harvie.

Harvie teaches that forming one side of the masking film with a matte patterned embossment has many advantages over a masking film without the matte patterned embossment, in addition to preventing block on a roll or wrinkle during winding. Harvie also teach that the matte patterned embossment is added to the non-adhesive side of the masking film in order to provide brand identification and/or written marketing, instructional or advertising materials without the need for expensive and time consuming printing processes (col.1, 1.55-64 and col.2, 1.56-61). Although Gotoh may not specifically require the embossed pattern for prevention of blocking and wrinkling and although brand identification and/or written marketing, instructional or advertising materials can be placed on smooth and rough surfaces, one of ordinary skill in the art would have recognized that the embossed patterns of Harvie would improve the masking film of Gotoh by providing the indicia without the expensive and technically more difficult printing processes. Therefore, there is motivation to combine Gotoh and Harvie without disregarding

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Gotoh's teachings or finding Gotoh's composition as flawed. Thus, one of ordinary skill in the art at the time Applicant's invention was made would have combined the teachings of Gotoh and Harvie in order to improve the masking film of Gotoh for the reasons taught by Harvie.

7. Applicant's arguments regarding the 35 U.S.C. 103 rejection of claim 5 over Gotoh in view of Harvie and Okumura have been fully considered but they are not persuasive.

In response to Applicant's argument that Gotoh and Harvie fail to render obvious claim 1 and therefore the addition of Okumura will fail to render claim 5 obvious, the reasons for why Gotoh and Harvie render claim 1 obvious are presented above.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will

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expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

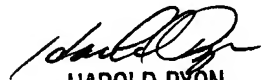
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher P Bruenjes
Examiner
Art Unit 1772
CPB
October 27, 2005


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

10/31/05